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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/116,425	07/15/1998	ROBERT J. PIECHOWIAK	M-2760-3P	2543

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SKJERVEN MORRILL LLP
25 METRO DRIVE
SUITE 700
SAN JOSE, CA 95110

EXAMINER
CHERUBIN, YVESTE GILBERTE

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/116,425	Applicant(s) PIECHOWIAK ET AL.	
	Examiner Yveste G. Cherubin	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 September 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4 and 6-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 6-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This office action is in response to the Amendment of the Application No. 09/116,425 filed on September 26, 2002 in which claim 5 is cancelled, claims 17-20 added. Thus claims 1-4, 6-20 are pending in the Application.

Priority Date

2. The Examiner is aware that this Application is a continuation in part of Application No. 08/727,805 (now Patent No. 6,012,982) filed on October 7, 1996, which is a continuation in part of Application No. 08/200,121 (now Patent No. 5,580,309) filed on February 22, 1994. Since the invention claimed in this instant Application does not carry priority of the above cited Applications, the Examiner is using the art reference to Thomas et al. (US Patent No. 6,190255) filed on July 31, 1998 to reject the present claims 1-14. A filing date of July 31, 1998 is accorded to the instant claims.

Specification

3. The amendment filed February 14, 2002 (Paper No. 15) is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the bonus game being a non-random game. In respect to Fig 7, page 19, line 10-15, the specification reads "The letters are not necessarily illuminated in the order BONUS; the order of the letters may be *randomly* chosen ..... In respect to Fig 8, page 20, lines 14-16, the specification reads "the bonus game may even be

a *random* multiplier of the base award in the main game or some automated game. In respect to Fig 9, which is directed to the claimed invention, the Applicant fails to elaborate on how the bonus game is being displayed.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 6-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1-4, 6-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner went through the specification and noted that nowhere in the specification does it read that the bonus game is being a non-random game, meaning, there is no support for the non-random bonus display in the specification. In respect to Fig 7, page 19, line 10-15, the specification reads "The letters are not necessarily illuminated in the order BONUS; the order of the letters may be *randomly* chosen ..... In respect to Fig 8, page 20, lines 14-16, the

specification reads "the bonus game may even be a *random* multiplier of the base award in the main game or some automated game. In respect to Fig 9, which is directed to the claimed invention, the Applicant fails to elaborate on how the bonus game is being displayed.

b. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17, line 7, recites "associating a second particular first game result.." What does the Applicant encompass by "second particular first game result "? Is the Applicant referring to the "bonus game result"?. The cited expression is ambiguous and is being interpreted by the Examiner as the bonus game result. Clarification is required.

Claims 18- 20 are being rejected as being dependent upon rejected base claim 17.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 6-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marnell II (US Patent 5,393,057) in view of Manship and further in view of Thomas (US Patent No. 6,190,255)

As per claims 1-2, 4, 9, 14, Marnell II dislcoses essentially all the claimed features in this instant application. Marnell II's system, in Fig 1, discloses an electronic machine that has the ability to display two games in one machine, a primary gaming device such as a poker gaming device or a slot machine and a secondary gaming device such as a bingo gaming device, see 2:35-45. Upon the occurrence of winning hands in the primary game, players receive an award and the secondary game or bonus game is generated, see 6:14-27. Upon winning of the secondary game, players will receive an additional award, see 6:14-27. Marnell II' s system discloses the use of coins or tokens to grant award, see 4:26-51. In Figs. 1 and 2, it's clear that grid patterns, playing cards, video reel symbols, numbers and letters are used as the different types of indicia. However, Marnell does not disclose using one display to present the outcomes of both games. Manship discloses using one display to display first game and secondary or bonus game. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide one display as taught by Manship for financial purposes. Marnell in view of Manship both fail to disclose their bonus game being a non-random game. Thomas discloses a slot machine wherein the bonus game can be a grid pattern being filled by the player's selection of window, (see abstract), 10:25-45. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the non-random teaching bonus game into the Marnell in view of Manship type

system in order to provide control to the players and therefore heighten the excitement of the game. As per claims 3, 6, Manship discloses that the bonus credit total is added to the credit total, 6:51-60. As per claims 8, 13, Manship in Fig 2, discloses using video reels. As per claims 7-16, Marnell, II, in Figs. 1 and 2, displays different types of indicia such as playing cards and letters, as shown.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4, 6, 8-11, 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomas et al. (US Patent No. 6,190,255).

As per claims 1-2, 4, Thomas et al discloses a bonus game for a slot machine operable in a basic mode and a bonus mode. The bonus game is entered upon the occurrence

of a special start bonus game outcome in the basic mode. Thomas discloses that the basic game in his system can be implemented on video reels, 3:65-67. Further, in 9:50+, Thomas discloses the bonus game being implemented on video displays. Thomas further discloses the bonus game being illustrated on a grid wherein the grid spaces can be filled by the player's selection and not at random, 9:58+, 10:1-60. In reference to Fig 1, although Thomas discloses a display (12) for the basic game and a second display (32) for the bonus game, Thomas further discloses in the case where both the basic and the bonus games are being implemented in video (which is the case) each game may be shown on the same video display, 5: 27-34 and (see abstract). The reference is deemed to meet the invention as claimed. Regarding claims 3, 6 Thomas discloses providing supplemental award during the bonus game outcome, 11:51-60. As per claims 10-11, 15-16, in reference to Figs 8, 9, Thomas discloses using bonus game result comprising letters and numbers, as shown. As per claims 8, 13, Thomas discloses using video reels, 3:65-67. As per claims 9, 14, Thomas discloses using indicia to fill grid pattern, 9:58+.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 7, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al in view of Marnell.

As per claims 7, 12, Thomas disclose the claimed invention as substantially as shown above. However, Thomas fails to disclose his symbols representing playing cards. Marnell discloses an electronic machine that has the ability to display two games in one machine, and wherein the primary game displays symbols representing playing cards. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the playing cards of Marnell in the Thomas' system in order to provide different types of game and therefore enhance the gaming system by attracting different types of players.

Response to Arguments

8. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yveste G. Cherubin whose telephone number is (703) 306-3027. The examiner can normally be reached on 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (703) 308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

December 14, 2002

ygc

JESSICA HARRISON
PRIMARY EXAMINER

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability Extensions of time may NOT be obtained under the provisions of 37 CFR 1 136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication See 37 CFR 1 85(a)

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application